

REMARKS

The last Office Action of August 1, 2006 has been carefully considered. Reconsideration of the instant application in view of the foregoing amendments and the following remarks is respectfully requested.

In an interview which was conducted by the undersigned with the Examiner on or about December 5, 2006, the Examiner was informed and has agreed that applicant would file two declarations under Rule 132 to show that the claimed invention fulfilled a special need in the field to which the invention pertains and that the device has been commercially successful.

Each of the declarants Dr. James Goodrich and Dr. Joseph Niamtu III, are experts in their respective fields relating exclusively to surgical procedures on humans; one in the area of neurosurgery and the other one in the area of cosmetic surgery. In each case, the surgical procedures by these experts require the absolute highest level of skill in surgical techniques and one of the primary objects is to avoid tissue damage during the procedure.

In both cases, each of the declarants has personally used the present invention and has obtained superior results as compared to carrying out surgical procedures without the present invention.

Furthermore, in each case, the declarant has stated that the Schmid reference cannot serve as an electrode for surgical procedures however that electrode might be viewed by the office. The Schmid electrode is not a surgical electrode.

The Examiner states that the uses of the medical instrument are not determinative. Applicant has contended that there is a critical difference between electrodes used for surgical use and those for external use i.e. EKG use as the Schmid reference represents. Applicant takes the position that applicant is entitled to at least the presumption that "new use" of an electrode. New use of a known device such as an electrode should be patentable. In this context, claim 30 claims an electrode for surgical procedures. Thus, the Examiner's statement should lead to an allowance of at least claim 30.

In view of the declarations submitted, which established the criticality of the medical instrument, the Examiner's rejection is believed overcome.

The claims (none of which were presently amended) recite ranges outside the reference, in particular, the range of germanium is critical in the electrode of the invention due to the effect of heat generation, which proves detrimental to biological tissue in surgery. This aspect is also the subject of the experts' declarations.

Alternatively, applicant submits that the Examiner's Final Rejection is premature and should be withdrawn. Applicant should be given another period in which to respond to any remaining issues.

On May 25, applicant filed an RCE following a Final Rejection by the Examiner. In the RCE, applicant presented amended claims. In particular, applicant had then amended the claims in response to the Examiners' rejection under 35 U.S.C §112, first paragraph on the range of germanium, which previously was considered as not specifically supported by the description.

In the RCE, applicant had submitted amended claims in which the range of the germanium was changed to reflect more closely the ranges as set forth in the description. Applicant contends that by virtue of the amendment, the claims were changed and the current Final Rejection the Examiner issued was thus premature.

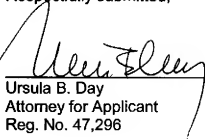
Furthermore, in the last Office Action, claim 20 recited already a range of germanium outside the range of germanium as taught by Schmid. Schmid was cited under 35 U.S.C. §103 against claim 21 but not against claim 20. The Examiner could have made the rejection under 35 U.S.C. §103 but did not. Therefore, the Examiner should not be able to use the present 35 U.S.C. §103 rejection as "a new ground of rejection" allegedly necessitating the current Final Rejection.

Accordingly, applicant respectfully requests that the current finality of the rejection be withdrawn and applicant be provided with an opportunity to address issues the Examiner now raised in the Office Action.

CONCLUSION

In view of applicant's afore-addressed issues and the submission of declarations by two experts, the Examiner should allow the claims; alternatively withdraw the finality of the present Office Action to allow the applicant another opportunity to reply.

Respectfully submitted,

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